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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,274	10/31/2003	Wu Su-Syin	ASP5012USNP	2049
26285 7590 03/17/2008 KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222				
EXAMINER				
JOYNER, KEVIN				
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1797				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/699,274

**Applicant(s)**

SU-SYIN, WU

**Examiner**

KEVIN C. JOYNER

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 18, 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (U.S. Patent No. 5,766,561) in view of Adam (U.S. Patent No. 5,851,995).

4. Concerning the limitations of claims 1, 2, 6, 8 11 and 14-18 Frieze discloses a method and apparatus of a sterilization container system comprising: an enclosure (12) defining an interior volume (as shown in Figure 1); an upwardly facing surface in the interior volume (as shown in Figure 2); a flexible elastomeric mat (10) formed of silicone

(as disclosed in the title), having a downwardly facing surface resting upon the upwardly facing surface (as shown in Figure 1); and a pattern of ridges extending from the downwardly facing surface (as shown in Figure 3B). Frieze does not appear to disclose that the pattern on the downwardly facing surface is such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges. Adam discloses a flexible elastomeric mat having a downwardly facing surface and an upwardly facing surface wherein the downwardly facing surface rests upon an upwardly facing surface (Figures 1-7). The reference continues to disclose that a pattern of ridges extend from the downwardly facing surface, wherein the pattern of ridges is such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges, said pattern being a continuous pattern that extends substantially across a dimension of the lower surface (concerning claim 17, 18Figure 6A). The pattern is provided in order to produce a set of recesses that allow said mat to cushion an object that may be present on the upwardly facing surface (column 2, lines 1-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Frieze to include a pattern of ridges extend from the downwardly facing surface, wherein the pattern of ridges is a continuous pattern that extend substantially across a dimension of the lower surface such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges in order to produce a set of recesses that allow said mat to cushion an object that may be present on the upwardly facing surface as exemplified by Adam.

5. In regards to the limitations of claims 3-5, Frieze in view of Adam is relied upon as set forth in reference to the limitations stated above. Claims 3-5 further require that the ridges have a height of 1.0 to 4.0 mm. It would have been well within the purview of one of ordinary skill in the art to optimize the length of the ridges between 1.0 to 4.0 mm maximize the cushioning affect of said pattern. Only the expected results would be attained. Concerning the limitation of claims 9, 10 and 20, Frieze further discloses that the mat further comprises a plurality of upwardly projecting members (as shown in Figure 2 labeled numeral 30) as well as a plurality of apertures therethrough (as shown in Figures 4A and 4B labeled numeral 40). Concerning the limitations of claims 12 and 19, as broadly defined Frieze also discloses a discontinuous pattern of "S" shaped ridges from one side of the mat to the other in Figure 3B.
6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (U.S. Patent No. 5,766,561) in view of Adam (U.S. Patent No. 5,815,995) as applied to claim 6 above, and further in view of Kerr et al. (U.S. Pub. No. US 2001/0046582).
7. Frieze in view of Nord is relied upon as set forth in reference to claims 1-6, and 8-14 above. Frieze in view of Nord does not appear to disclose that the silicone has a hardness of less than 90A on the Shore A Scale. Kerr discloses a novel cleated anti-creep floor mat made with silicone having a hardness of less than 90A on the Shore A Scale (column 3, paragraph 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to comprise the silicone material with a hardness of less than 90A on the Shore A Scale in order to provide the necessary cushioning effects as exemplified by Kerr.

8. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frieze et al. (U.S. Patent No. 5,766,561) in view of Nakahira (U.S. Patent No. 4,429,068).

9. Frieze discloses a method and apparatus of a sterilization container system comprising: an enclosure (12) defining an interior volume (as shown in Figure 1); an upwardly facing surface in the interior volume (as shown in Figure 2); a flexible elastomeric mat (10) formed of silicone (as disclosed in the title), having a downwardly facing surface resting upon the upwardly facing surface (as shown in Figure 1); and a pattern of ridges extending from the downwardly facing surface (as shown in Figure 3B). Frieze does not appear to disclose that the pattern on the downwardly facing surface comprises a pattern of concentric shapes such that no fold line can traverse the mat from one side to the other without intersecting a plurality of ridges. Nakahira discloses a flexible elastomeric mat having a downwardly facing surface and an upwardly facing surface such that the downwardly facing surface rests upon the upwardly facing surface (Figures 1-6). The reference continues to disclose that said mat comprises a pattern of concentrically shaped ridges wherein the pattern is such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge (column 10, lines 40-66; Figures 1-6). Said pattern and ridges are provided in order to reduce vibrations that may disturb an object located on the upward facing surface of said mat. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Frieze to include pattern of concentrically shaped ridges on a downwardly facing surface wherein the pattern is such that no fold line can

traverse the mat from one side to the other without intersecting at least one ridge in order to reduce vibrations that may disturb an object located on the upward facing surface of said mat as exemplified by Nakahira.

### ***Response to Arguments***

10. Applicant's arguments filed January 18, 2008 have been fully considered but they are not persuasive.

*Applicant's principle arguments are:*

*(a) Applicant contends that the rough surface of Nord cannot be both a downwardly facing surface and a pattern of ridges. Applicant submits that if a surface, whether smooth or rough, was both a surface and a pattern of ridges, the recitation of a pattern of ridges in Claim 1 would be superfluous.*

The Examiner does not concede that Nord does not provide a downwardly facing surface with a plurality of ridges. A rough surface is in fact, a smooth surface with protrusions on it in order to produce said rough surface. These protrusions are ridges as broadly defined. However, to further prosecute the claims, a new rejection is provided that more clearly provides a downwardly facing surface with a pattern or ridges such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge as set forth above.

*(b) It would appear that the Examiner misunderstands the importance of the claimed ridges. Referring to paragraph [25] of the Subject Application, the claimed*

*ridges can decrease the tendency of a mat to roll, or fold over; during a sterilization process and it is the pattern of ridges being such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge.*

11. In response to applicant's argument that the pattern of ridges is in a pattern such that no fold line can traverse the mat from one side to the other without intersecting at least one ridge in order to prevent folding, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN C. JOYNER whose telephone number is (571)272-2709. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leigh McKane/  
Primary Examiner, Art Unit 1797

KCJ